

REMARKS

Claims 1, 2, 3, 5, and 7 - 9 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejection in view of the amendments and remarks contained herein.

Applicants thank the Examiner for the courtesies extended to the Applicants' representative, Jason A. Heist, in the telephonic interview of February 18, 2004. In the telephonic interview, the rejection under 35 U.S.C. § 112, first paragraph and the claimed particle size of the magnetic powder were discussed. Specifically, support for the claimed coercive force was pointed out to the Examiner to overcome the rejection under 35 U.S.C. § 112, first paragraph. In view of this disclosure, the Examiner agreed to withdraw the rejection.

With respect to the claimed particle size, the differences between the claimed particle size and Panchanathan were discussed, but no agreement was reached.

REJECTION UNDER 35 U.S.C. § 112

Claims 1 – 3, 5, and 7 – 9 stand rejected under 35 U.S.C. § 112, first paragraph, as being indefinite for failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

The Examiner alleges that the claimed coercive force in the range of 400-720 kA/m is not supported in the specification as filed and, therefore, is new matter. Applicant's, however, respectfully point the Examiner to page 26 of the application where it states, "It is preferred that the intrinsic coercive force (H_{CJ}) of the bonded magnet at room temperature is 320 – 720 kA/m,

and 400-640 kA/m is more preferable.” In view of this disclosure, Applicants respectfully assert that the claimed coercive force in the range of 400 – 720 kA/m is sufficiently supported by the specification as filed.

Notwithstanding, Applicants have amended claim 1 to call for an intrinsic coercive force in the range of 478 – 720 kA/m. This subject matter is disclosed, for example, in Table 1 of the application (Sample 3). Further, Applicants have amended claim 1 to call for a particle size of 0.5 – 80 μ m. This is supported, for example, at page 19, line 3. As such, reconsideration and withdrawal of this rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 1 – 3, 5, and 7 - 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over each of Panchanathan, (U.S. Pat. No. 5,725,792 cited by the Applicants in the IDS submitted January 4, 2001). This rejection is respectfully traversed.

In the Response to Arguments section of the outstanding Office Action, the Examiner states, “The teachings of a reference are not limited to merely that which is set forth in the examples or the disclosed preferred embodiments.” As such, the Examiner has taken the position that Panchanathan is not limited to any particular particle size, but rather encompasses any powder particle size including the claimed particle size of 0.5 – 80 μ m. Applicants, however, respectfully assert that the powder size of 200 μ m as taught by Panchanathan is not taught with “sufficient specificity to constitute an anticipation under the statute.” See MPEP 2131.03.

If the claims are directed to a narrow range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable

to conclude that the narrow range is not disclosed with “sufficient specificity” to constitute anticipation of the claims. Further, unexpected results may also render the claims unobvious. In view of this, Applicants respectfully refer the Examiner to the attached Affidavits Traversing the Rejection under 37 C.F.R. 1.132. These affidavits, executed by the inventors of the application, provide support for the unexpected results achieved by the claimed particle size of 0.5 – 80 μm .

In view of the above, Applicants respectfully assert that Panchanathan’s broad teaching of a 200 μm particle size does not anticipate the claimed particle size of 0.5 – 80 μm . Moreover, the claimed particle size is critical for achieving the claimed coercive force of 478 – 720 kA/m, which is much greater than a coercive force of 399.5 kA/m that is taught by Panchanathan, because the claimed particle size assists in preventing oxidation of the magnetic powder and deterioration of the magnetic properties during the milling process. See pages 18-19 of the application. As such, the unexpected results of the claimed particle size render the claimed invention unobvious in view of Panchanathan. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

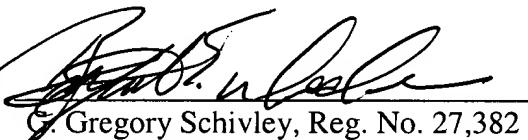
CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: May 20, 2004

By:



G. Gregory Schivley, Reg. No. 27,382
Bryant E. Wade, Reg. No. 40,344

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

GGS/BEW/JAH